

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. of: MCCORMACK, Michael & SORENSEN, Thomas

Appln. No.: 09/890,126

Examiner: to be assigned

Filed: September 27, 2001

Art Unit: to be assigned

For: ELECTRICAL ENERGY METER

**DECLARATION OF DAVID BROPHY**

I, DAVID BROPHY, do hereby declare and say:

1. I am at least 18 years of age, and am competent to testify to the matters set forth herein.

2. I am a European Patent Attorney associated with the firm of F.R. Kelly & Co., having a principal office at 27 Clyde Road, Dublin 4, Ireland.

3. F.R. Kelly & Co. represents SMF Technologies PLC, the employer of the above-named applicants at the time of the above-referenced invention. (At the time of the above-referenced invention, SMF Technologies PLC was called Suparule PLC, but in the meantime underwent a change of name. For the avoidance of confusion this company will be referred to herein as "SMF".)

4. F.R. Kelly & Co. also represents Suparules Limited which is the wholly owned subsidiary of SMF and which is the company nominated by SMF to hold all patent rights in respect of inventions belonging to SMF.

5. On August 3, 2001, I forwarded the application papers associated with the above-referenced application to SMF and requested them to obtain the signatures of the above-named applicants, and I forwarded a reminder letter on August 23, 2001.

6. During September, 2001, I spoke with Mr. John McDonnell, managing director of both SMF and Suparules Limited, regarding the above-referenced United States patent application, and the need to obtain the signatures of Messrs. McCormack and Sorensen. Mr. McDonnell informed me that he attempted to contact Mr. McCormack by telephone on September 20 and 21 with regard to obtaining his signature on the declaration associated with the above-referenced application, but was unable to contact Mr. McCormack despite leaving messages on his answering machine.

7. On September 28, 2001, I forwarded the declaration via registered post to Mr. Michael McCormack at his last known address, namely, 29 Fearnog, Shannon, County Clare, Ireland, along with a letter informing him of the deadline of November 7, 2001 for filing such

documents in the United States, and an assignment document relating to U.S. rights in and to the invention. A copy of that correspondence is attached hereto as Exhibit 1.

8. On October 15, 2001, our firm received a letter from Mr. McCormack stating his intention to seek legal advice instead of signing the declaration forwarded to him with my letter of September 28, 2001. A copy of Mr. McCormack's refusal is attached hereto as Exhibit 2.

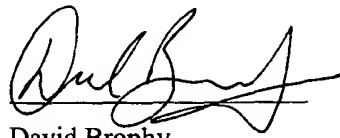
9. On November 13, 2001 we received a further letter from the firm of Holmes O'Malley Sexton, Mr. McCormack's solicitors, refusing to execute the assignment and making his signing of the declaration conditional on the payment of (i) IR£1,000 (approximately US\$1150) and (ii) an undetermined further sum in respect of the fees of Holmes O'Malley Sexton. A copy of this letter from Holmes O'Malley Sexton is attached hereto as Exhibit 3.

10. On December 5, I replied to Holmes O'Malley Sexton repeating our request for Mr. McCormack's signature on the basis of his obligations as an employee of SMF at the time of the invention. A further complete copy of the Application papers including the Declaration and Power of Attorney, the Assignment and the PCT specification and drawings was enclosed with this letter and copied directly to Mr. McCormack. A copy of this letter of December 5 is attached hereto as Exhibit 4.

11. Since December 5, 2001, Mr. McCormack has failed to provide a signed copy of the declaration.

12. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such wilful false statements may jeopardize the validity of the application or any patents issuing thereon.

February 1, 2002  
Date

  
David Brophy



**F. R. KELLY & CO.**

EUROPEAN PATENT ATTORNEYS • COMMUNITY TRADE MARK ATTORNEYS



Mr Michael McCormack  
29 Fearnog  
Shannon  
Co. Clare

To avoid unnecessary delay,  
please quote our reference!

Your Ref : ---  
Our Ref : pf05119/PC/DB/cg

**By Registered Post**

September 28, 2001

Dear Mike,

**US Patent Application  
National Phase of PCT/IE 00/00012  
"Electrical Energy Meter"  
SUPARULES LIMITED**

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**COPY**

I enclose herewith the Declaration which is required for the above US patent application (this is the national phase of PCT/IE00/00012 on which you and Tom Sorenson are named as inventors, and which was filed on January 28, 2000).

I should be obliged if you would sign and date the enclosed form on the line indicated and return this to me at your earliest convenience. This must be filed in the US no later than **November 7, 2001**.

I also enclose a formal assignment of US rights which I would ask you to sign and date where indicated.

If you have any queries relating to the enclosed or if you anticipate any difficulty in returning them to me before the due date, I should be obliged if you would contact me as soon as possible.

Yours sincerely,

David Brophy

Encl.

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• OLIVER FENTON ALAN WALLACE GAVAN FERGUSON DAVID BROPHY\* CONOR BOYCE\*

\* European Patent Attorney

Consultant: Martin Tierney

Offices at Belfast and Alicante

To: Philip Coyle  
FR Kelly & Co  
27 Clyde Road,  
Dublin 4

Mike McCormack  
29 Fearnog  
Shannon  
Co. Clare

Date: 15/10/01.

Without Prejudice.

Dear Philip,

Further to our telephone conversation of today regarding David Brophy's letter to me dated the 18<sup>th</sup> of October (?). I wish to confirm that I will be seeking legal advice regarding the matter.

As I stated in the course of our conversation I cannot guarantee that the legal review will be complete in time for your deadline of the 7<sup>th</sup> of November, but I am sure that you will appreciate that I must protect my own interests in this matter, by having independent legal advice. Also, given that I left the company in January of this year, there would have been plenty of time for me to conduct the review had the company acted more swiftly.

I am travelling to the UK tomorrow, and I am back at the end of the week, I will therefore be arranging a meeting with my Lawyer on Monday next the 22<sup>nd</sup> of October.

  
Best Regards

Mike McCormack



HOLMES O'MALLEY SEXTON  
SOLICITORS

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Dublin 4.  
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5 Pery Square,  
Limerick, P.O. Box 146,  
Ireland

Telephone +353 61 313222  
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LDE No. 3007

Our ref.

Your ref.

Date

HF/KO/PLT1819/YOB

PF05119/PC/DB/CG

13/11/01

**WITHOUT PREJUDICE**

**RE: OUR CLIENT – MICHAEL MCCORMACK  
YOUR CLIENTS – SMF TECHNOLOGIES/SUPARULES LIMITED**

Dear Sirs,

We refer to the above matter and to Kieran Oliver's conversation with your David Brophy on the 9th of November.

Without prejudice our client may be prepared to sign the document headed "declaration/utility or design patent application" namely the patent document relating to the power consumption meter but he is not prepared to sign the general deed of assignment headed "assignment" (a copy of which I have enclosed) as this relates to a number of co-inventions other than the power consumption meter. Our client intends to review each patented application on an individual basis and if appropriate will sign the relevant patent document. However before signing the patent document relating to the power consumption meter invention, we have the following requirements:

1. He agrees that any patent he has entered into on behalf of the company during the course of his employment is the property of the company. He will not however agree to remove his name from any patent that he was instrumental in drafting whether on behalf of the company or not, for any consideration. Furthermore any inventions which he may make in the future will not be assigned over to SMF Technologies and Mr. McCormack wants it clearly set out in writing that Suparules/SMF Technologies will not attempt to force the assignment of any patent of Mr. McCormack by saying the idea for the patent was a result of his having worked in SMF Technologies/Suparules. He also does not want the fact that he has agreed to assign his interest in the electrical energy meter to set a precedent meaning other inventions he makes will automatically be assigned over the Suparules.
2. Mr. McCormack has incurred direct and indirect expenses as a result of having to assign over his interest in the electrical energy meter. Through business interruption, phone calls etc. he is of the view that expenses in the amount of £1,000.00 are owing to him

[www.homs.ie](http://www.homs.ie)

Gordon A. Holmes James I. Sexton John F. Hayes Margaret V. O'Connell H. Patrick Barriscala  
Joseph A. O'Meara Harry Fehily Audrey A. Healy Robert A. Bourke Donal M. Creaton

Peter J. Power Thomas M. McEvoy Robert Kennedy Fiona Manning Terence Heaney Rosemary Hynes

The Irish Member of The International Lawyers Network



HOLMES O'MALLEY SEXTON  
SOLICITORS

together with the cost of obtaining legal advice herein. Our own continuing fees are also payable. Mr. McCormack also wants it made known that the payment of these expenses will not in any way prejudice his rights regarding his past present or future intellectual property rights.

You might liase with your clients regarding the above and come back to us with your proposals.

Yours faithfully,

*HOM.*

Holmes O'Malley Sexton



**F. R. KELLY & CO.**

EUROPEAN PATENT ATTORNEYS • COMMUNITY TRADE MARK ATTORNEYS



Holmes O'Malley & Sexton  
5 Pery Square  
Limerick

To avoid unnecessary delay,  
please quote our reference!

Your Ref : HF/KO/PLT1819/YOB

Our Ref : pf05119/PC/DB/cg

**Attention : Mr Kieran Oliver**

By Facsimile (letter only) and Post [No of Pages: 2]  
061-310 414

December 5, 2001

Dear Sirs,

**US Patent Application  
National Phase of PCT/IE 00/00012  
"Electrical Energy Meter"  
SUPARULES LIMITED**

We refer to your letter dated November 13, 2001, and apologise for the delay in responding.

I am enclosing a further and final copy of the Declaration and Power of Attorney document, the Assignment, and a copy of International Application No. PCT/IE00/00012.

You have commented that the Assignment appears to be a general assignment. This is not the case as you will note from the first paragraph where reference is specifically made to the invention entitled "Electrical Energy Meter" as described in the enclosed specification.

Our client is of the opinion that the contract of employment previously signed by Mr McCormack is clear and unambiguous in that Mr McCormack has undertaken on an ongoing basis to sign any documents necessary for the prosecution of patent applications which are in respect of inventions made during the course of his employment. There can be no doubt that the invention which is the subject of the enclosed patent application was made during Mr McCormack's employment given that he himself instructed us to file the applications naming himself and Mr Sorenson as co-inventors and Suparules Limited as Applicant. Since the enclosed documents for signature are specific to the enclosed application we can see no reasonable justification for Mr McCormack refusing to sign the documents.

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OLIVER FENTON ALAN WALLACE\* GAVAN FERGUSON DAVID BROPHY\* CONOR BOYCE\*

\* European Patent Attorney

Consultant: Martin Tierney

Offices at Belfast and Alicante

We would therefore request that the documents be signed and returned to us without further delay, which is resulting in additional unnecessary expense to our client.

To expedite matters we are copying this letter and each of the enclosures to Mr McCormack. We await your early response.

Yours faithfully,  
F. R. KELLY & CO.

*c.c.: Mr Mike McCormack, 29 Fearnog, Shannon, Co. Clare*